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FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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NAWAZ, ASAD M

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHUWU WU and JAMES CRAWFORD

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Appeal 2009-1204  
Application 09/810,159  
Technology Center 2400

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Decided: <sup>1</sup> May 4, 2009

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Before LEE E. BARRETT, JOSEPH L. DIXON, and  
LANCE LEONARD BARRY, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-25, 37-39 and 41-44. Claims 26 and 40 have been canceled, and claims 27-36 have been withdrawn from consideration. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

An oral hearing was held on April 23, 2009.

We reverse.

## A. INVENTION

The invention at issue on appeal relates to voice instant messaging. (Spec. 1.)

## B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

### 1. A communications method comprising:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host;

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender;

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient; and

enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host.

### C. REFERENCES

The Examiner relies on the following references as evidence:

Cook                      US 6,879,665 B1                      Apr. 12, 2005

Introduction to PowWow (Mar. 1, 2000) available at [http://web.archive.org/web/20000301125635/ww2.tribal.com/help/online\\_docs/h205voic.html](http://web.archive.org/web/20000301125635/ww2.tribal.com/help/online_docs/h205voic.html) (retrieved Apr. 3, 2006) (hereinafter “PowWow”).

### D. REJECTIONS

The Examiner makes the following rejections.

Claims 1-25, 37-39, and 41-44 stand rejected under 35 U.S.C. § 103(a) as being obvious over Cook in view of PowWow.

## II. ISSUE

Have Appellants shown error in the Examiner's initial showing of obviousness? Specifically, has the Examiner provided a teaching of “presentation of a first text instant messaging graphical user interface . . . conditioned on communication of the text instant message between the sender and the recipient”?

## III. PRINCIPLES OF LAW

### 35 U.S.C. § 103(a)

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415-16 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 416. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 417.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 416). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 550 U.S. at 418).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

## VI. ANALYSIS

With respect to representative independent claim 1, Appellants' Summary of the Claimed Invention states that the text instant messaging system further "enables users to establish voice communication with each other." Appellants' Summary of the Claimed Invention for independent claim 1 states that "[m]anipulation by the recipient 602 b of the START TALK button 710 is enabled to invoke voice communication between the sender 602a and the recipient 602 b through the host 604." (App. Br. 2).

Cook teaches an e-mail system with an appended prior voice message attached thereto, and Appellants argue that the system of Cook is "substantially different from an instant messaging system." (App. Br. 5). We agree with Appellants, and we find the teachings of PowWow to be more relevant than the teachings of Cook which is limited to non-real time communication using appended voice files. While we find the teachings of PowWow to be more relevant than the teachings of Cook, we are left to speculate as to the specifics of the user interface for the instant message or integrated voice usage in PowWow. We could speculate that there would necessarily have to be some type of user interface method 2 of PowWow instructs the user to "[c]lick the Voice button on the window's button bar. (This button is displayed only when two or more people are connected through the Personal Communicator.)." The "Personal Communicator" of

PowWow tends to imply some type of stored relationship for two users. However, the brief disclosure of PowWow does not teach or fairly suggest that the presentation of the user interface is "conditioned on communication of the text instant message between the sender and the recipient" as recited in independent claims 1, 21, and 22. Furthermore, we find no teaching in Cook concerning the condition precedent of reception of a text message to presentation of a graphical user interface. Nor do Cook or PowWow teach or fairly suggest a conditional limitation that "the presentation of the first text instant messaging graphical user interface being conditioned on whether the recipient is determined to be capable of accepting voice communication" as set forth in independent claim 44.

In Cook, we find presentation in a graphical user interface with a voice message as shown and figures 5A and 5B, but we find no express teaching of a textual message as a condition precedence to presentation of the graphical user interface for use in voice communication between the sender and recipient through the instant messaging host computer. Appellants argue that neither Cook nor PowWow teaches "enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient." (App. Br. 4-5). Appellants argue that the teachings of PowWow at page 2 merely teaches some sort of being "connected through the personal Communicator window," but this falls short

of communication of a text message as a condition precedent to display of the graphical user interface. (App.Br. 7).

While we may speculate as to the operation of the instant messenger interface of PowWow, we find no express teaching or suggestion that would support any reasoned finding concerning how PowWow interfaces with a user to implement the voice communication. This would require speculation on our part. We decline to rely upon speculation to decide this appeal. Therefore, we find the Examiner's initial showing to be lacking with respect to the steps of "enabling presentation of a first instant text messaging graphical user interface" and "enabling manipulation by the recipient of the icon to invoke voice communication" and we find the Examiner has not met the requisite initial burden. Therefore, we cannot sustain the Examiner's rejection of independent claims 1, 21, and 22 and their respective dependent claims 2-20, 23-25, 37-39, and 41-43.

With respect to independent claims 44, Appellants argue that in addition to the above discussed pre-condition to display of the graphical user interface, independent claim 44 contains an additional step of "determining in response to receipt of the text instant message, the capabilities of the recipient to accept voice communications." (App. Br. 8). Appellants contend that neither Cook nor PowWow teaches or fairly suggests the above limitations. From our review of the Examiner's rejection in the Answer, we find no discussion of either Cook or PowWow with respect to the additional "determining" step and the Examiner merely sets forth that the claim contains similar limitations as the above rejected claim 1 and is rejected under similar rationale. Since we found the Examiner's an initial showing to



be lacking above, what we find it similarly lacking with respect to independent claim 44 and additionally find no teaching or fair suggestion concerning the "determining" step. Therefore, the Examiner has not set forth a sufficient initial showing of obviousness of independent claim 44.

## V. CONCLUSION

For the aforementioned reasons, Appellants have shown error in the Examiner's initial showing of obviousness. Specifically, the Examiner has not shown that Cook or PowWow provided a teaching of "presentation of a first text instant messaging graphical user interface . . . conditioned upon communication of the text instant message between the sender and the recipient."

## VI. ORDER

We reverse the obviousness rejections of claims 1-25, 37-39, and 41-44.

REVERSED

msc

FISH & RICHARDSON P.C.  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022